Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte CEDELL ADAM ALEXANDER, JR.,
CHARLES ALLEN CARRIKER, JR.,
JIM PHILIP ERVIN,
MATTHEW BLAZE SQUIRE,
and
DEEPAK VIG

_____

Appeal No. 2001-0910
Application No. 08/903,756

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ON BRIEF

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Before BARRETT, RUGGIERO, and DIXON, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-23, which are all of the claims pending in the present application.

The claimed invention relates to establishing communication between a plurality of emulated networks overlaid onto at least one base network in which communication takes place over source route bridges. A determination is made that communication is to occur between at least two entities on the network through a source route bridge. The source route bridge returns the base network address of the target entity to the source entity enabling the source entity to communicate directly with the target entity using the base network protocol, thereby bypassing at least one of the source route bridges. According to Appellants (specification, pages 9 and 10), the processing and delay associated with the bypassed source route bridges is avoided resulting in enhanced network communication.

Claim 1 is illustrative of the invention and reads as follows:

> 1. A method for achieving enhanced performance in communications between a plurality of emulated networks overlaid onto at least one base network, wherein said communications involve one or more source route bridges, said method comprising the steps of:
>
> determining when communication is to occur, through said one or more source route bridges, and between at least two entities where a first of said at least two entities is a member of a first emulated network and where a second of said at least two entities is a member of another of said plurality of emulated networks;

communicating to said first entity, one or more base network addresses that identify the location of an entity closely correspondent to said second entity in said at least one base network; and

thereafter utilizing said one or more base network addresses instead of emulated network addresses in communication between said first and second entities such that communications between said first and second entities is established and such that at least one of said one or more source route bridges is bypassed and such that the processing and delay associated with said at least one bypassed source route bridge is avoided wherein said performance in communications involving said at least two emulated networks is enhanced.

The Examiner relies on the following prior art:

DeSimone et al. (DeSimone) 5,905,872 May 18, 1999
(filed Nov. 05, 1996)

Claims 1-4, 6-11, 13-20, 22, and 23 stand finally rejected under 35 U.S.C. § 102(e) as being anticipated by DeSimone.

Claims 5, 12, and 21 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over DeSimone.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs[1] and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the DeSimone reference does not fully meet the invention as set forth in claims 1-4, 6-11, 13-20, 22, and 23. With respect to the Examiner's obviousness rejection, we are also of the view that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill

[1]The Appeal Brief was filed July 7, 2000 (Paper No. 9). In response to the Examiner's Answer dated September 28, 2000 (Paper No. 10), a Reply Brief was filed November 30, 2000 (Paper No. 11), which was acknowledged and entered by the Examiner as indicated in the communication dated December 14, 2000 (Paper No. 12).

in the art the obviousness of the invention as recited in claims 5, 12, and 21. Accordingly, we reverse.

We consider first the rejection of claims 1-6 under 35 U.S.C. § 102(e) as being anticipated by DeSimone. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to independent claims 1, 8, and 15, the Examiner attempts to read the various limitations on the disclosure of DeSimone. In particular, the Examiner directs attention (Answer, pages 4, 5, 9, 10, 14, and 15) to the

illustration in Figure 4 of DeSimone along with the accompanying description beginning at column 4, line 31.

Appellants' arguments in response assert a failure of DeSimone to disclose every limitation in independent claims 1, 8, and 15 as is required to support a rejection based on anticipation. Appellants' arguments focus (Brief, pages 5 and 6; Reply Brief, page 4) on the contention that there is no determination in DeSimone of when communication is to occur through source route bridges as claimed. Instead, in Appellants' view (id., at 5), DeSimone performs a rerouting of communication " . . . irrespective of whether or not a source route bridge is in the path of communication" leading to Appellants' further assertion that, therefore, there is no bypassing of source route bridges in DeSimone, as also required by each of the appealed independent claims.

After reviewing the DeSimone reference in light of the arguments of record, we are in general agreement with Appellants' position as expressed in the Briefs. Our interpretation of the disclosure of DeSimone coincides with that of Appellants, i.e., while DeSimone suggests the rerouting of communication through a short-cut direct network communication to avoid communication

through a string of routers, there is no determination that communication is to occur through source route bridges and that the source route bridges will be bypassed on the establishment of a direct network connection as required by Appellants' claims. We also agree with Appellants that in the only place where communication through a bridge is mentioned in DeSimone, i.e., the Figure 5 embodiment, communication always takes place through the bridge, in contrast to the claimed source route bridge bypassing feature.

We also recognize that the Examiner's comments in the "***Response to Arguments***" portion of the Answer at page 29, line 1 suggest the possible reliance by the Examiner on the supposed equivalence of source route bridges and routers. We find the record to be totally devoid of any evidence to support such an assertion.[2] The Examiner must not only make requisite findings,

[2] As additional support for the stated rejection, the Examiner cites (Answer, page 24) excerpts from the Halsall text book titled "Data Communications, Computer Networks and Open Systems." To whatever extent this reference may be applicable to the instant claimed invention, we will not consider it because it is not part of the statement of the rejection and may not be properly relied upon. "Where a reference is relied on to support a rejection whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of the rejection." In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). See also Ex parte Raske, 28 USPQ2d 1304, 1305 (Bd. Pat. App. & Int. 1993). We would point out, however, that our cursory review of Halsall reveals that, in contrast to any suggestion of equivalence of bridges and routers by the Examiner, this reference clearly sets forth the art recognized distinction between bridged LANs and router-based LANs.

based on the evidence of record, but must also explain the reasoning by which the findings are deemed to support the asserted conclusion. See In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

In view of the above discussion, since all of the claim limitations are not present in the disclosure of DeSimone, we do not sustain the Examiner's 35 U.S.C. § 102(e) rejection of independent claims 1, 8, and 15, nor of claims 2-4, 6, 7, 9-11, 13, 14, 16-20, 22, and 23 dependent thereon.

We also do not sustain the Examiner's 35 U.S.C. § 103(a) obviousness rejection of dependent claims 5, 12, and 21 based on DeSimone. Each of the claims incorporates the source route bridge communication determination and bypass features of independent claims 1, 8, and 15, features which we found lacking of any teaching or suggestion in

DeSimone as discussed supra. Further, since the Examiner has, in our view, improperly interpreted the disclosure of DeSimone, the issue of the obviousness of these features has not been addressed.

In summary, we have not sustained the Examiner's rejections of any of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-23 is reversed.

REVERSED

LEE E. BARRETT Administrative Patent Judge	)	
JOSEPH F. RUGGIERO Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOSEPH L. DIXON Administrative Patent Judge	)	

JFR:hh

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